

## REMARKS

This Application has been reviewed in light of the Final Office Action mailed December 12, 2008. At the time of the Final Office Action, Claims 1-9, 11, 12 and 24-26 were pending in this Application. Claim 26 was allowed and Claims 1-9, 11, 12, 24 and 25 were rejected. Claims 1 and 11 have been amended to further define various features of Applicants' invention. Applicants respectfully request reconsideration and favorable action in this case.

### **Rejections under 35 U.S.C. §103**

Claims 1-9, 11-12 and 24-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,156,056 issued to Kearns et al. ("Kearns"). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

When determining whether a claim is obvious, the Examiner must make "a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, it is well settled that obviousness requires at least a suggestion of all the features in a claim. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (*citing In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, "*there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*" *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

With respect to claim 1, Kearns does not disclose a device with slits extending substantially axially and defining ribs therebetween, each of said ribs comprising a fixed proximal end, an intermediate section, and a fixed distal end, and said second configuration characterized by the intermediate section expanding radially outward. Rather, the device disclosed by Kearns appears to have a plurality of slits that extend in a substantially perpendicular or circumferential orientation defining a plurality of projecting members. Therefore, Kearns does not at least suggest all of the elements of claim 1 as amended, and cannot

render obvious amended claim 1. For at least these reasons, Applicants respectfully submit that claim 1 as amended is in condition for allowance and request withdrawal of the rejection.

With respect to claim 11, Kearns does not disclose a device with slits extending substantially axially and defining ribs therebetween, each of said ribs comprising a fixed proximal end, an intermediate section, and a fixed distal end. Rather, the device disclosed by Kearns appears to have a plurality of slits that extend in a substantially perpendicular or circumferential orientation defining a plurality of projecting members. Therefore, Kearns does not at least suggest all of the elements of claim 11 as amended, and cannot render obvious amended claim 11. For at least these reasons, Applicants respectfully submit that claim 11 as amended is in condition for allowance and request withdrawal of the rejection.

Claims 2-9, 12, 24 and 25 depend directly or indirectly from amended claims 1 or 11. Applicants repeat and hereby incorporate the above remarks regarding amended claims 1 and 11. Applicants respectfully submit that claims 2-9, 12, 24 and 25 are in condition for allowance, and request withdrawal of the rejection.

#### **New Claims**

Claims 27-31 have been added to further define Applicants' invention.

#### **Allowable Subject Matter**

Applicants appreciate the Examiner's indication that Claim 26 is allowed over the art of record.

#### **Request for Continued Examination (RCE)**

Applicant encloses a Request for Continued Examination (RCE) Transmittal, and hereby authorized the Commissioner to charge \$810 to Deposit Account No. 50-0359 of ArthroCare Corporation.

#### **Information Disclosure Statement**

Applicants enclose an Information Disclosure Statement and PTO Form 1449, with copies of the references for the Examiner's review and consideration.

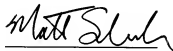
### CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

The Commissioner is hereby authorized to charge \$810 for the RCE to Deposit Account No. 50-0359 of ArthroCare Corporation. Applicant believes there are no additional fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.358.5925.

Respectfully submitted  
Attorney for Applicants,



Matthew Scheele  
Reg. No. 59,847

Date: 5/12/09

CORRESPONDENCE ADDRESS:

ARTHROCare CORPORATION

CUSTOMER NO. **21394**

512.358.5925

512.391.3901 (fax)

Enclosure: 1) Information Disclosure Statement and PTO Form 1449, with copies of the references.